

R E M A R K S

The present invention comprises an improved camouflage system that generally relates to clothing used for avoiding visual detection in natural environments. The present invention employs a substrate 20 that comprises an open fabric base in the form of interlaced netting. Camouflage elements 25(a) and 25(b) are employed to meet the objectives of the present invention [FIGURE 3]. Each camouflage element 25(a) and 25(b) employs a central, elongated segment that are secured to the netting. The ends of the central segment 26(a) of camouflage element 25(a) are axially extended into lobed segments 28(a). The periphery of lobe segments 28(a) comprise lobes extending in opposition to the axis thereof and being directed forwardly in opposition to central segment 26(a). Camouflage element 25(b) includes an elongated central segment 27(b) each end of which axially extends into lobed segments 28(b) [FIGURE 2b]. The periphery of lobed segments 28(b) consist of a plurality of lobes 29(b) that are oriented rearwardly towards central segment 27(b). When camouflage elements 25(a) and 25(b) are coupled to the netting, the lobes 29(a) and 29(b) will be opposed to each other and thereby generally depict or simulate the appearance of leaves from indigenous bushes, flowers or trees [FIGURES 3, 4].

The Examiner rejected Claims 1 - 12, inclusive, under 35 U.S.C. 103 as being unpatentable over Muirhead in view of Humphreys. The Examiner stated:

"Muirhead discloses an interlaced open matrix/netting of closed loop members (20) and a plurality of camouflage colored elements (40, 42, 46) being three dimensional simulated the natural environment and each of the elements is coupled to one of the closed loop members, col.5, lines 13-28 and as shown in figure 4C. Further, the interlaced matrix is coupled to an outer surface of a garment as shown in figure 4A. However, Muirhead does not show the plurality of camouflage elements being defined by dimensioned first and second simulation segments having aligned, opposed lobes disposed on opposite sides of a central segment thereof.

Humphreys discloses an interlaced open matrix/netting of closed loop members and a plurality of first and second camouflage elements (44) being three dimensional simulates the natural environment and each of the elements is coupled to one of the closed loop members, col.8, line66 - col.9,line7. Further, the plurality of camouflage elements are each defined by dimensioned first and second simulation segments having aligned, opposed lobes disposed on opposite sides of a central segment thereof as shown in figure 4.

It would have been obvious to one skilled in the art at the time the invention was made to provide the garment matrix of Muirhead with the plurality of first and second camouflage elements with each defined by dimensioned first and second simulation segments having aligned, opposed lobes disposed on opposite sides of a central segment thereof as taught by Humphreys as an alternative but equivalents means of allowing the wearer of the device to blend with the natural surroundings or as required for a particular application thereof."

Muirhead teaches structure for a camouflage covering fabricated by attaching jute strands to netting (FIGURE 4C). The jute strands 40 are formed such as twine or thread rather than woven forms.

Humphreys teaches a camouflage structure that employs a net matrix 16 to which substantially uniform strips 44 and 46 are coupled. The strips 44 and 46 are elongated members defined by a 4-sided polygon.

The rule governing the test of patentability has been firmly established and must be determined by consideration of the subject matter sought to be patented.¹ The present invention employs camouflage elements that are neither disclosed nor inferred by the prior art. Each camouflage element 25(a) and 25(b) comprises a central elongated segment, each end of which axially extends into lobed segments. In one form of the camouflage segment (i.e., 25(a)), the lobe extending from the lobed segments are oriented forwardly in opposition to the central segment [FIGURE 2a]. In the other form of the camouflage element (i.e., 26(a)), the lobes are oriented rearwardly toward the camouflage segment [FIGURE 2b]. It is the opposing orientation of the lobes on the camouflage elements that produce a visually disruptive pattern and thereby cause the user to appear to become visually part of the adjacent natural environment.

Without any support whatsoever, the Examiner contended it would have been obvious to one having skill in the art to incorporate the "aligned, opposed lobes" that are part of the camouflage elements of the present invention. It is submitted that neither Muirhead nor Humphreys, either alone or in combina-

¹ Graham v. John Deere Co., 383 U.S. 1 (1966)

tion disclose or infer these essential limitations of the present invention as embodied in the amended claims. Therefore, it is further submitted these references are improperly applied for the purpose of rejecting the claims, as amended.

In the case of In re Lundsford, 148 U.S.P.Q. 716 (C.C.P.A., 1966), the Court reversed the decision of the Board of Appeals and, finding the invention patentable, stated:

"In the final analysis, as in all section 103 cases, we must look first to the differences between the prior art and the subject matter sought to be patented and then determine if what appellant did, or made, as a whole, would have been obvious."² (Emphasis of Court)

The differences between Applicant's invention and the teachings of Muirhead and Humphreys are sufficiently comprehensive to support a finding that what Applicant did would not have been obvious to one having skill in the art at the time the invention was made.

It is only through the use of hindsight after reviewing Applicant's invention one could even attempt to apply the references relied upon by the Examiner to contend that the presently claimed invention is obvious. At the time Applicant's invention was made, the invention cannot be said to have been obvious since the cited references fail to disclose, teach or suggest the combination or structural features recited in the claims, as

² In re Lundsford, supra, 148 U.S.P.Q. at 720.

amended. The need for direction by the prior art itself is a rule which has been well established and reaffirmed repeatedly.³

In the case of In re Aufhauser, 158 U.S.P.Q. 351 (C.C.P.A., 1968), the rejection of claims under 35 U.S.C. §103 was reviewed. In reversing the Examiner's rejection and the Board's affirmance thereof, the Court stated:

"The fundamental error of the Board and the Examiner seems to us to have arisen from their analysis of the art as if it contained the knowledge of Appellant's invention. In other words, they proceeded to combine the prior art as if Appellant's invention was included therein as a part of the knowledge possessed by one of ordinary skill in the art. Such an analysis does not comport with that required by Graham v John Deere Co., *supra*.

Instead, there as in United States v. Adams, 383 U.S. 39, 248 U.S.P.Q. 497 (1966) what Appellant has done was to observe an existing problem in the art which had not been solved by the prior art and then to combine individually old concepts to solve that problem." (Emphasis added)⁴

As in this matter, In re Aufhauser reversed a decision where the teachings of a plurality of references were combined. It is submitted the Examiner has interpreted the references as if Applicant's invention was included. The specific structural relationship between the lobes 29(a) and 29(b) on the respective camouflage elements 25(a) and 25(b), respectively, are the focus

³ Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q. 2d 1434 (Fed. Cir., 1988); cert. den. 109 S.Ct. 75 (1988); W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir., 1983); cert. den. 469 U.S. 851; 105 S.Ct. 172 (1984)

⁴ In re Aufhauser, *supra*, 158 U.S.P.Q. at 355.

of the present invention; neither are disclosed nor inferred in Muirhead or Humphreys. In the absence of direction by the reference, a rejection under 35 U.S.C. §103 is improper.

The threshold burden imposed is one which requires the Examiner to present reasons for the conclusion of obviousness. The approach of the appellate courts has been to first determine whether the Patent and Trademark Office has a reasonable basis for holding the appealed claims unpatentable under 35 U.S.C. §103 for obviousness of the subject matter. The Court has adopted the phrase "prima facie obviousness" to describe a sufficient case which must be made out by the Examiner for obviousness based on the prior art references upon which he or she relies. For the Examiner to present a prima facie case to support the contention that the present invention is obvious in light of the teachings of the cited references, the prevailing cases require that four elements must be established:

- (a) There must be a basis in the reference for a modification;
- (b) There must be a reasonable expectation of success (obviousness to try is not the standard);
- (c) There must be some beneficial effect disclosed in the reference;
- (d) The prior art must render obvious the invention as a whole.

The case of In re Lintner, 173 U.S.P.Q. 560 (C.C.P.A., 1972), deals with the requirement that there must be a basis in

the reference to suggest or infer the modification. In Lintner, the court specifically defined the inquiry it undertakes in evaluating alleged *prima facie* obviousness, the Court stating:

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification."⁵

Application of the standards set forth in 35 U.S.C. §103 presumes the existence of differences between the subject matter claimed and the teachings of any particular prior art patent, publication or event, necessitating some modification of the particular item of prior art to arrive at the claimed invention. The assessment goes to the sufficiency of the reference teachings to justify the conclusion that the proposed modification is a reasonable and logical reconstruction of what a person having ordinary skill in the art would have found obvious to do at the time the invention was made.

The second element required to establish a *prima facie* case is that there must be a reasonable expectation of success. The Court stated, in In re Clinton, *supra*:

"We first consider the references by themselves to see whether they suggest doing what appellants have done ... [W]e then consider whether a person of ordinary skill in the art combining the individual steps which form the claimed process have a sufficient basis for the required expectation. Obviousness does

⁵ In re Lintner, *supra*, 173 U.S.P.Q. at 562.

not require absolute predictability, but a reasonable expectation of success is necessary."⁶

The requirement in In re Clinton, supra, is that there be some reasonable expectation of success with respect to the achievement of the objects of the invention. Closely tied to this notion is the concept that it must be concluded that the proposed modification would have been obvious to do, rather than merely obvious to try. In the case of In re Antonie, 195 U.S.P.Q. 6 (C.C.P.A., 1977), Judge Baldwin observed:

"The PTO and the minority appear to argue that it would be obvious for one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter effected the result. As we have said many times, obvious to try is not the standard of 35 U.S.C. §103." (Emphasis added) ⁷

In the present case, neither Muirhead nor Humphreys discloses or infers the use of the opposing lobes incorporated by the camouflage elements of the present invention. Despite that fact, the Examiner stated it would have been obvious to one having skill in the art to employ the opposed, aligned lobes. Where there is no evidence in the record that the prior art recognized that modification of a specific parameter would affect the results, the Examiner's argument fails to support the critical element necessary to establish a *prima facie* case of obviousness.

⁶ In re Clinton, supra, 188 U.S.P.Q. at 367.

⁷ In re Antonie, supra, 195 U.S.P.Q. at 8.

The final element which must be established is that the prior art must render obvious the invention as a whole. All of the limitations set forth in the claims must be considered in the examination of obviousness or non-obviousness. A large line of cases⁸ require that the Examiner consider all aspects of the claimed invention. An artificial dissection of that subject matter which has the effect of precluding from consideration features which are recited in the claims is contrary to the requirements of a prima facie case of obviousness.

The structural requirements of Applicant's camouflage elements 25(a) and 26(a) are neither disclosed nor inferred in any of the references. It is therefore submitted the failure of the references to: (a) specifically describe or infer the critical limitations required by the claims, as amended, or (b) disclose or direct the modification between Applicant's invention and that disclosed in the cited reference, precludes the establishment of the necessary prima facie case of obviousness. It is therefore submitted that the rejection of the Examiner has been overcome.

The Examiner cited Egnew, United States Patent No. 6,910,223. Since these references were not used for the purpose of rejecting any claims, no further discussion of these patents is deemed necessary at this time.

⁸ In re Kuehl, 177 U.S.P.Q. 250 (C.C.P.A., 1973); In re Mancy, 182 U.S.P.Q. 303 (C.C.P.A., 1974); In re Hirao, 190 U.S.P.Q. 15 (C.C.P.A., 1976).

It is therefore submitted the amendments made to the claims and the remarks set forth herein overcome the grounds supporting the rejection of the claims and the case is now in condition for allowance, and such action is respectfully requested.

Respectfully submitted,



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